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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,467	09/11/2006	Cheung Hoi Yu	2055.043	7542

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EXAMINER	
CHUNDURU, SURYAPRABHA	
ART UNIT	PAPER NUMBER
1637	
MAIL DATE	DELIVERY MODE
04/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/555,467	YU ET AL.	
	Examiner	Art Unit	
	Suryaprabha Chunduru	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-19 and 26-41* is/are pending in the application.

4a) Of the above claim(s) *1,2,4,17-19 and 26-41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 November 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/14/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of Group II (claims 5-19) in the reply filed on March 19, 2009 is acknowledged. With regard to the election of one SEQ ID No. for examination, Applicants' arguments are fully considered and found unpersuasive. Applicants argue that the individual sequences cannot constitute independent and distinct inventions. The arguments are found unpersuasive because as discussed in the previous office action, the oligonucleotide comprise different base sequences and constitute patentably distinct structures or variants of a gene. These variants result in patentably distinct sequences with different structures. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141. By statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant... to elect that invention to which his claim shall be restricted." 37 CFR 1.142 (a). See also 37 CFR 1.141(a). Hence each sequence would constitute a distinct inventive entity and the restriction requirement for election of one SEQ ID No. is still deemed proper.

Status

2. Claims 5-16 along with SEQ ID NO. 1 are considered for examination. Claims 1-2, 4, 17-19 and 26-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group and non-elected SEQ ID NOs.

Priority

3. This application filed on September 11, 2006 is a 371 of PCT/CN04/00434 filed on April 30, 2004 claims foreign priority UNITED KINGDOM 0310181 filed on May 02, 2003.

Information Disclosure Statement

4. The Information Disclosure Statement filed on February 14, 2006 has been considered and acknowledged.

Objection to the Specification

5. The Specification is objected because of the following informalities:

(i) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see at least page 29, line 22). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claims 5, 6, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Dean et al (US 6,617,137).

Dean et al. teach a method of claim 5, for nucleic acid detection comprising the steps of nucleic acid isolation followed by nucleic acid amplification and subsequently real time PCR (see col. col. 37, line 10-50, col. 38, line 7-24, col. 45, line 5-55).

With regard to claim 6, Dean et al. teach that the nucleic acid amplification comprises PCR (see col. 37, line 22-50, col. 45, line 17-34).

With regard to claim 8, Dean et al. teach that said nucleic acid is DNA (see col. 37, line 10-25, col. 45, line 5-21).

B. Claims 5-6, 8-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Peiris et al (US 7,375,202).

Peiris et al. teach a method of claim 5, 10, for nucleic acid (RNA) detection comprising the steps of nucleic acid isolation followed by nucleic acid amplification and subsequently real time PCR (see col. 27, line 8-54, col. 34, line 49-64).

With regard to claim 6, Peiris et al. teach that the nucleic acid amplification comprises PCR (see col.34, line 55-64).

With regard to claim 8, Peiris et al. teach that the nucleic acid is cDNA (see col. 34, line 49-64).

With regard to claim 9, 13, Peiris et al. teach that the nucleic acid is SARS coronavirus cDNA (see col. 27, line 8-54).

With regard to claim 11, Peiris et al. teach that the method further comprises obtaining RNA from the biological sample and converting the RNA to cDNA using reverse transcriptase (see col. 34, line 49-64).

With regard to claim 12, Peiris et al. teach that the steps amplification and real time PCR uses primers (see col. 34, line 49-64).

With regard to claims 14-16, Peiris et al. teach that the primers and probes correspond to SEQ ID NO. 1 (See col. 9, line 40-54). Accordingly the claims are anticipated.

C. Claims 5-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Peiris et al (US 7,267,942).

Peiris et al. teach a method of claim 5, 10, for nucleic acid (RNA) detection comprising the steps of nucleic acid isolation followed by nucleic acid amplification and subsequently real time PCR (see col. 11, line 16-47, col. 34, line 49-64).

With regard to claim 6, Peiris et al. teach that the nucleic acid amplification comprises PCR (see col. 11, line 16-47).

With regard to claim 7, Peiris et al. teach that said real time PCR uses fluorescently labeled probes (see col. 11, line 23-47).

With regard to claim 8, Peiris et al. teach that the nucleic acid is cDNA (see col. 11, line 23-30).

With regard to claim 9, 13, Peiris et al. teach that the nucleic acid is SARS coronavirus cDNA (see col.14, line 30-67).

With regard to claim 11, Peiris et al. teach that the method further comprises obtaining RNA from the biological sample and converting the RNA to cDNA using reverse transcriptase (see col. 11, line 16-47).

With regard to claim 12, Peiris et al. teach that the steps amplification and real time PCR uses primers (see col.11, line 23-47).

With regard to claims 14-16, Peiris et al. teach that the primers and probes correspond to SEQ ID NO. 1 (see col. 14, line 44-58). Accordingly the claims are anticipated.

Conclusion

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637